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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/531,365

04/14/2005

Dorothee Nerot

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EXAMINER

IM, JUNGHWA M

ART UNIT

PAPER NUMBER

2811

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/25/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/531,365

Applicant(s)

NEROT ET AL.

Examiner

Junghwa M. Im

Art Unit

2811

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3-11 is/are allowed.
- 6) ☒ Claim(s) 12-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 19-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 19 and 20 recite the limitation "a microcircuit is connected to the wiring pad in the first set of conducting elements after the first support element has been overmoulded." It is unclear which element is the first of conducting elements in the instant invention.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 12, 14, 16-17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steffen (US 6,071,758) in view of Haghiri-Tehrani et al. (US 4,460,825), hereinafter Haghiri-Tehrani.

Regarding claim 12, Fig. 4 of Steffen shows a support strip (1 in Fig. 1) comprising:

a first metal grid (a upper portion of c's in Fig. 1) comprises a conducting element having a contact pad (5) and a wiring pad (a portion where the wire 8 is connected);

a second metal grid (a lower portion of c's in Fig. 1) comprises a conducting element having a contact pad (5) and a wiring pad (a portion where the wire 8 is connected).

Fig. 4 of Steffen shows most aspects of the instant invention, however, fails to show that the first and the second metal grids are connected to the at least one gripping area using a snap-off junction area. Fig. 14 of Haghiri-Tehrani shows a support strip (65) comprising at least one roughly parallel gripping area (shown as dashed lines along the leads 4) and the support element (carrier element inside the cast casing 63 and leads 4) is connected to the at least one gripping area using a snap-off (punch-out) junction area (col. 5, lines 16-20).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the teachings of Haghiri-Tehrani into the support strip of Steffen in order to have the first and the second metal grids connected to the at least one gripping area using a snap-off junction area to reduce the steps of cutting and trimming of the IC module card.

Regarding claim 14, Steffen discloses that the support strip wherein the support element is metallic (col. 2, lines 64-66).

Regarding claims 16-17, Fig. 1 of Steffen shows that the support element is arranged to receive an electronic component/microcircuit (6).

Regarding claim 20, insofar as understood, Fig. 1 of Steffen shows a microcircuit (6) is connected to the wiring pad (8) and overmoulded (10)."

4. Claims 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steffen in view of Haghiri-Tehrani as applied to claim 12 above, and further in view of Nishikawa et al. (US 5,581,065), hereinafter Nishikawa.

Regarding claim 13, the combination of Steffen/Haghiri-Tehrani shows most aspect of the instant invention except the support element comprises a foolproofing edge. Fig. 2 of Nishikawa shows a support element (IC carrier) comprises a foolproofing edge (11b).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the teachings of Nishikawa into the support element of Steffen/Haghiri-Tehrani in order to have the support element (IC carrier) comprising a foolproofing edge to secure the position of the carrier into the selected slot (col. 7, lines 13-15).

Regarding claim 15, the combination of Steffen/Haghiri-Tehrani shows most aspect of the instant invention except “the support element has a contour whose geometry substantially complies with the standard GSM 11.11.” Nishikawa discloses a support element (chip carrier) which geometry complies with the standard GSM 11.11 (col. 22, lines 58-65).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the teachings of Nishikawa into the support element of Steffen/Haghiri-Tehrani in order to have the support element (chip carrier) with a contour which geometry substantially complying with the standard GSM 11.11 to meet the European Telecommunication Standards.

5. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Steffen in view of Haghiri-Tehrani as applied to claim 13 above, and further in view of Luu (US 6,641,049).

Regarding claim 14, the combination of Steffen/Haghiri-Tehrani shows most aspect of the instant invention except “the support element comprises a second foolproofing edge.” Fig.

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5A of Luu shows a support element (IC carrier) comprises a second foolproofing edge (two chamfered corners).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the teachings of Luu into the support element of Steffen/Haghiri-Tehrani in order to have the support element (IC carrier) comprising a second foolproofing edge to secure the positioning of two IC's.

Allowable Subject Matter

6. Claims 3-11 are allowed.

Response to Arguments

7. Applicant's arguments with respect to pending claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

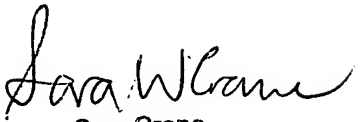
will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Junghwa M. Im whose telephone number is (571) 272-1655. The examiner can normally be reached on MON.-FRI. 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard T. Elms can be reached on (571) 272-1869. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

jmi


Sara Crane
Primary Examiner